REMARKS

This is in response to the Office Action of October 19, 2007. Non-elected claims 4-9 are cancelled, without prejudice to their reassertion in a divisional application. No new matter is introduced by this Amendment. Claims 1, 10-12, and 14 are pending in the present application. Reconsideration of the application is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1, 10-12 and 14 were rejected on page 2 of the Office Action under 35 U.S.C. § 112, first paragraph. This ground of rejection is respectfully traversed.

This ground of rejection involves the question of whether certain language now recited in the claims has adequate support in the underlying disclosure in the specification. Applicant had pointed out that the language in question – "over 490 mm in the width direction" – was calculated by the formula: 490 mm = 550 mm (width of the thermoplastic resin film) – 30 mm (removed parts as selvage) x 2. The Examiner contends that the 30 mm which was removed as selvage from both ends of the film by a cutter "could have been very well removed from the length of the optical film and not the width" of the film. That is, the Examiner's position is that "both ends" of the film could mean the beginning and end of the film rather than the sides of the film.

In this regard, the Examiner's attention is respectfully directed to disclosure from line 15 on page 12 through line 6 on page 13 of the specification:

> A width of the thermoplastic resin film after passing through the cooling drums becomes narrower by 2 to 10% due to neck-in comparing with a width of a molten thermoplastic resin immediately after being extruded from a die (same as a width of a lip of the die). An ***end of the thermoplastic resin film in the width direction***

> (hereinafter, also simply referred to as "an end") has a thicker thickness and larger optical distortion comparing with those on other parts of the film.
>
> In the present invention, since the thermoplastic resin film after cooling is for an optical use, normally, ***sides thereof are suitably cut off*** before winding with a wind drum. ***The cut off parts will be called "selvage" in the present invention.*** A part of the cooled thermoplastic resin film yet to be stretched after removing parts to be the selvage will be referred to as "an optical film" in the present invention.

Emphasis supplied. It is quite clear from this that the "selvage" is removed form the width of the film – that is, the sides of the film. Accordingly, the Amendment filed February 1, 2007 is fully supported by the disclosure.

It is, therefore, respectfully submitted that the requirements of the first paragraph of 35 U.S.C. § 112 are met. Reconsideration and withdrawal of this ground of rejection are earnestly solicited.

Rejection Under 35 U.S.C. § 102(b)

Claims 1, 10-12, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2001-337221 to Sawada Takahiko (JP '221). This rejection is respectfully traversed.

The Examiner contends that it is obvious – to modify the alicyclic structure of JP '221 to have an Re value[1] less than 2 nm, due to the fact that the reference teaches that is it known to process thermoplastic resin films having an Re value less than 2 nm (citing Example 4 in the reference) in order to meet end user specifications – since it has been held that discovering an optimum value/workable ranges involves only routine skill in the art.

Applicant respectfully contends that Example 4 of JP '221 relates to optical film of

[1] The amount of retardation provides an index for indicating optical distortion of thermoplastic resin films. The symbol "Re" designates "retardation amount."

olefin-N-alkylamide based resin, and has no relevancy to the alicyclic structure that is expressly required in the present invention. As is confirmed from the entire description and working embodiments of Applicant's specification, the Re value does not depend on the type of the alicyclic structure, but rather depends on manufacturing conditions of the film. Indeed, in all working Examples and Comparative Examples of the present specification, the same resin was used, but film forming conditions were varied. Therefore "modification of the alicyclic structure" as asserted by the Examiner could not provide the solution to the problem. The optical film of the present invention is obtained by film forming method under specific manufacturing conditions[2]. JP '221 is entirely silent as to the specific manufacturing conditions taught and claimed in the present invention. Moreover, there is no reasonable motivation to modify the film forming condition taught in JP '221. Therefore, JP '221 does not render the present invention obvious.

Withdrawal of the rejection of claims 1, 10-12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over JP 2001-337221 is in order and is earnestly solicited.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher, Registration No. 28,781, at the telephone number below, in order to expedite prosecution in connection with the present application.

---

[2] The present optical film is obtained by using a melt extruding machine wherein an alicyclic polymer film satisfies a relation of the formula $[\sin^2 2\alpha] \times [\sin^2 (\pi \cdot Re/550)] \leq 3.4 \times 10^{-5}$ over the whole surface of the film when an angle made by the extruding direction of the film from the melt extruding machine and a slow phase axis at each point is α and a retardation amount at each point is Re.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: January 18, 2008

Respectfully submitted,

By  #28,781
Raymond C. Stewart
Registration No.: 21,066
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant